REMARKS

Claims 1, 2, 6-9, 11-20 and 24-27 are in the application. Claims 1, 2, 6-9, 11-14, 16, 17, 20, 26, and 27 are currently amended; claims 3-5, 10, and 21-23 are cancelled; claims 24 and 25 were previously presented; and claims 15, 18, and 19 remain unchanged from the original versions thereof. Claims 1, 16, and 20 are the independent claims herein.

Applicant respectfully notes that the Office Action dated September 16, 2005 includes a number of references to Applicant's Response filed September 16, 2004, as opposed to the most recent prior response filed with the Office on July 7, 2005. (See Final Office Action dated September 16, 2005, p. 2-3, 6-7, and 15, *Response to Arguments*) Applicant's Response filed on July 7, 2005 addressed the issues raised on pages 2-3, 6-7, and 15. Applicant respectfully submits that the Final Office Action dated September 16, 2005 is confusing, ambiguous, and neither totally clear nor logical in presentation of the rejections and reasoning due to the Examiner's repeated discussion of the Response filed September 16, 2004. In particular, the Examiner repeats statements regarding the specification and statements made in the September 16, 2004 filed Response, as opposed to the pending claims.

However, in an effort to advance prosecution of the present application, Applicant presently submits claim amendments herewith in reply to the Final Office Action dated September 16, 2005. In the event that the presently presented Response does not place the application in a condition for allowance, Applicant respectfully requests the reconsideration and withdrawal of the finality of the pending rejections.

No new matter is added to the application as a result of the presently presented Response. Reconsideration and further examination are respectfully requested.

Claim Rejections Under 35 USC § 112, 1st Paragraph

Claims 1-2, 4-9, 11-22, and 24-27 were rejected under 35 U.S.C. 112, 1st paragraph, as failing to comply with the enablement requirement. This rejection is respectfully traversed.

Applicant respectfully submits that each of claims 1, 2, 6-9, 11-22, and 24-27 submitted herewith for entry and consideration are in compliance with the enablement requirement per 35 USC 112, 1st paragraph. That is, the claims contain subject matter that is in fact described in the specification in a manner that is clear, concise, and in exact terminology so as to enable one skilled in the art to which the claims pertain.

In particular, the claims have been amended to delete the language cited as offensive by the Examiner. For example, all recitations of "structuring with a processor", "predetermined criteria", "scaled numeric value", and "scaled alphanumeric value" have been deleted from the claims.

Applicant respectfully submits that the recited aspects of receiving information relating to a person's status, receiving information relating to a plurality of risk assessment factors, assigning a numerical value to each of the plurality of risk assessment factors, assigning a weight to each of the plurality of risk assessment factors, calculating the plurality of risk factors and the risk quotient, and providing the suggested action stated in independent claims 1, 16, and 20 are stated in clear, concise, and exact terms. Additionally, the claimed "providing a suggested action" is, at least, evidence of a practical and concrete result.

Furthermore, support for the submitted claim amendments may be found in the Specification at least at paragraphs [0045] – [0047] wherein explicit examples are disclosed regarding the risk assessment factors, the numerical values and weights assigned thereto, the calculation of the risk factors and the risk quotient (including exemplary values), and the providing of a suggested action based on the calculated risk quotient.

Applicant respectfully emphasizes that the applicable standard regarding 35 USC 112, 1st paragraph, is whether the specification enables one skilled in the art to practice the claimed invention. Applicant submits and maintains that each of receiving, assigning, calculating, and providing aspects of the claims would be fully understood by those skilled in the relevant art, particularly as such terms are used in the claims and discussed in the context of the specification.

Accordingly, Applicant respectfully requests the reconsideration and withdrawal of the rejection of claims 1, 2, 6-9, 11-20, and 24-27 under 35 USC 112, 1st paragraph.

Claim Rejections Under 35 USC § 112, 2nd Paragraph

Claims 1-2, 4-9, 11-22, and 24-27 were rejected under 35 U.S.C. 112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is respectfully traversed.

In light of the amendments submitted herewith, Applicant respectfully submits that the rejection under 35 USC 112, 2nd paragraph is overcome (i.e., moot). That is, the claims particularly and distinctly state that which is claimed by Applicant.

Therefore, Applicant respectfully requests the reconsideration and withdrawal of the rejection of claims 1, 2, 6-9, 11-20, and 24-27 under 35 USC 112, 2nd paragraph.

Claim Rejections Under 35 USC § 101

Claims 1-2, 4-9, 11-22, and 24-27 were rejected under 35 U.S.C. 101 because the claimed invention is allegedly directed to non-statutory subject matter. This rejection is respectfully traversed.

In light of the amendments submitted herewith, Applicant respectfully submits that the rejection under 35 U.S.C. 101 is overcome by the presently presented amended claims. In particular, the claimed invention is (1) within the technological arts and (2)

the claimed invention produces a useful, concrete, and tangible result (e.g., provide a suggested action associated with the legal action).

Therefore, Applicant respectfully requests the reconsideration and withdrawal of the rejection of claims 1, 2, 6-9, 11-20, and 24-27 under 35 USC 101.

Claim Rejections Under 35 USC § 103(a)

Claims 1-2, 4-9, 11-22, and 24-27 are rejected as being unpatentable over Heckman et al., U.S. Patent No. 5,875,431 (hereinafter, Heckman) in view of Halligan et al., U.S. Publication No. 2002/0077941 (hereinafter, Halligan). This rejection is respectfully traversed.

Regarding claims 1, 16, and 20, Heckman is directed to a closed loop legal strategic planning system for outlining objectives and tasks and their associated timing. Three closed loop control systems a) monitor legal costs, b) monitor attainment of objectives and c) control deliverables derived from completion of tasks (col. 1 lines 21-33). Heckman is directed to maximizing the likelihood of a desired legal outcome in connection with a legal action and control costs (col. 4 lines 63-68). A fundamental aspect of the Heckman invention, without which implementation of the invention would be impracticable, is directed to a strategic plan cost management strategy and bench marking elements (col. 15, ln. 40-49).

The Heckman system receives three kinds of data: initial data directed to the administrative and demographic particulars of each law firm subscribed to the system, case specific data relating to the present case, and case outcome feedback data from which future litigation/legal templates might be drawn (col. 16 lines 16- 21). Heckman describes how the three kinds of data can be applied to attain the objectives of the Heckman system (monitor legal costs, monitor attainment of objectives and control deliverables derived from completion of tasks).

Applicant respectfully submits that the Heckman does not disclose or suggest, at least, the claimed "assigning a numerical value to each of the plurality of risk

assessment factors, wherein the numerical value is indicative of a legal risk of each risk assessment factor relative to the other plurality of risk assessment factors; assigning a weight to each of the plurality of risk assessment factors; calculating a plurality of risk factor values by multiplying the numerical value and the weight assigned to each of the plurality of risk assessment factors; calculating a risk quotient for the legal action by summing the plurality of risk factor values; and in response to the calculated risk quotient, generating a suggested action associated with the legal action".

Regarding the cited and relied upon Halligan, it is noted that Halligan is directed to methods and a system in which selected data and other information about a trade secret is collected and characterized and entered into a specialized database with certain functions. The system includes a method and apparatus for documenting, analyzing, auditing, accounting, protecting, registering, and verifying a trade secret is disclosed. The method includes the steps of applying a plurality of generally accepted legal criteria to the content of the trade secret, assigning a value under each criterion and generating one or more metrics from the assigned values through the use of logical and mathematical processes, thereby allowing the comparison of results with predetermined threshold values. (See Halligan, Abstract and paragraph [0020])

Halligan discloses, "[T]rade secret is a recognized intellectual property right under United States laws, and also under the laws of many foreign countries. The other intellectual property protection provided to ideas is patent protection. Patent protection, unlike trade secret protection, requires disclosure." (emphasis added, paragraph [003]) That is, trade secrets are a form of intellectual property, just as patents, trademarks, and copyrights are forms of intellectual property. Each of the different types of intellectual property relate to and provide different types of protective rights. The rights protected by each category of intellectual property are not the same as or suggestive of a legal action (e.g., court proceeding or action involving adverse parties). A trade secret is no more a legal action than is a patent. While a trade secret and a patent may be at issue in a legal action, neither a trade secret nor a patent is explicitly, implicitly, or inherently part of or related to any legal action.

Applicant respectfully submits that Halligan does not disclose or suggest, at least, receiving information relating to a legal action. Halligan appears to disclose a legal reviewer reviewing and adding comments regarding information descriptive of a trade secret (paragraph [0022]), and legal criteria related to factors or tests applied to ascertain if information pertains to a trade secret as described in the U.S., Section 757 of the First Restatement of Torts. (paragraph [0009]) That is, the information regarding the trade secret is received and reviewed, not a legal action. The trade secret is a type of intellectual property that is defined and legally protected according to certain legal rules and laws. However, neither the trade secret nor the legal criteria that is mentioned and used in evaluating the trade secrets discussed in Halligan are "legal actions".

Halligan is not concerned with a managing or assessing a risk related to a legal action. Halligan is instead directed to the documentation, analysis, auditing, accounting, protection, registration, and verification of trade secrets.

Moreover, the alleged combination of Hackman and Halligan fails to disclose or suggest, at least, the claimed "assigning a numerical value to each of the plurality of risk assessment factors, wherein the numerical value is indicative of a legal risk of each risk assessment factor relative to the other plurality of risk assessment factors; assigning a weight to each of the plurality of risk assessment factors; calculating a plurality of risk factor values by multiplying the numerical value and the weight assigned to each of the plurality of risk assessment factors; calculating a risk quotient for the legal action by summing the plurality of risk factor values; and in response to the calculated risk quotient, generating a suggested action associated with the legal action".

Thus, it is clear that even if Heckman and Halligan were combined as asserted by the Examiner (not admitted as feasible by Applicant), the combination would not render claims 1, 16, and 20 obvious due to the patentable differences between the claims and the combination of Heckman and Halligan. Accordingly, Applicant respectfully submits that claims 1, 16, and 20 are patentable over Heckman and Halligan under 35 USC 103(a). Furthermore, claims 2, 6-9, 11-15, 17-19, and 24-27 depend from claims 1, 16, and 20. It is further submitted that all of the pending claims

1, 2, 6-9, 11-20, and 24-27 are patentable over Heckman and Halligan under 35 USC 103(a).

Accordingly, Applicant respectfully requests the reconsideration and withdrawal of the rejection of claims 1, 2, 6-9, 11-20, and 24-27 under 35 USC 103(a).

CONCLUSION

Accordingly, Applicants respectfully request allowance of the pending claims. If any issues remain, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is kindly invited to contact the undersigned via telephone at (203) 972-5985.

Respectfully submitted,

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Date

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